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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John M. Hall

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Intellectual Property Administration

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EXAMINER

LIN, KENNY S

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/974,064	<b>Applicant(s)</b> HALL ET AL.	
	<b>Examiner</b> Kenny Lin	<b>Art Unit</b> 2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 9/12/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/16/03, 9/12/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-28 are presented for examination.
2. The IDS have been considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack proper antecedence basis:

- i. Claim 20 - "the user email application" (user email application was never introduced in the parent claim).

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 5-19 and 20-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Kumar et al (hereinafter Kumar), US 6,240,445.

7. Claims 1-2, 5-19 and 20-28 are also rejected under 35 U.S.C. 102(e) as being anticipated by Kumar et al (hereinafter Kumar), US 6,240,445.

8. Kumar was cited by the applicant in the IDS submitted on June 16, 2003.

9. As per claim 1, Kumar taught the claimed invention including a method for providing notification to a user that a document was transmitted with a transmission device, comprising the steps of:

- a. Identifying the location of an email account of the user (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-27); and
- b. Sending a copy of the transmitted document to the user email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

10. As per claim 8, Kumar taught the claim invention including a system for providing notification to a user that a document was transmitted with a transmission device, comprising:

- a. Means for identifying the location of an email account of the user (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-27); and

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- b. Means for sending a copy of the transmitted document to the user email account  
(col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

11. As per claims 2 and 9, Kumar taught the invention as claimed in claims 1 and 8. Kumar further taught that the step of identifying the location of an email account of the user comprises identifying the location of the email account from user identity information entered into the transmission device (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-27).

12. As per claim 5, Kumar taught the invention as claimed in claim 1. Kumar further taught that the document has been transmitted by the transmission device via email (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

13. As per claim 6, Kumar taught the invention as claimed in claim 1. Kumar further taught that the document has been transmitted by the transmission device via facsimile (col.4, lines 59-67, col.5, lines 1-8).

14. As per claims 7 and 10, Kumar taught the invention as claimed in claims 6 and 8. Kumar further taught that the step of sending a copy of the transmitted document comprises creating a copy of a facsimile document, appending the created copy to an email message, and sending the email message to the user email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

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15. As per claim 11, Kumar taught the claimed invention including a transmission device (fig.4), comprising:

- a. A processing device (col.8, lines 45-51; processing device such as CPU is an inherent component of a computer); and
- b. Memory (col.8, lines 45-51; memory is an inherent component of a computer) including a notification module that is configured to send a copy of documents transmitted by the transmission device to an email account of the document sender (col.8, lines 45-51).

16. As per claim 12, Kumar taught the invention claimed in claim 11. Kumar further taught that the notification module is configured to send a copy of documents that were transmitted via email to the email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

17. As per claim 13, Kumar taught the invention claimed in claim 11. Kumar further taught that the notification module is configured to send a copy of documents that were transmitted via facsimile to the email account (col.2, lines 8-11, 24-25, col.4, lines 59-67, col.5, lines 1-8, col.7, lines 27-28, 33-37).

18. As per claim 14, Kumar taught the invention claimed in claim 13. Kumar further taught that the notification module is further configured to create a copy of facsimile document, append them to email messages, and send the email messages containing the appended copies to the email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

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19. As per claim 15, Kumar taught the invention claimed in claim 11. Kumar further taught that the transmission device is a multifunction peripheral (fig.4; computer).

20. As per claim 16, Kumar taught the claimed invention including a method for providing notification to a user that a document was faxed with a transmission device, comprising the steps of:

- a. Identifying the location of an email account of the user (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-27); and
- b. Sending a notification to the user email account (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-28).

21. As per claim 21, Kumar taught the claimed invention including a system for providing notification to a user that a document was faxed with a transmission device, comprising:

- a. Means for identifying the location of an email account of the user (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-27); and
- b. Means for sending a notification to the user email account (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-28).

22. As per claims 17 and 22, Kumar taught the invention claimed in claims 16 and 21.

Kumar further taught that the step of identifying the location of an email account of the user

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comprises determining the location of the email account from user identity information entered into the transmission device (col.2, lines 39-47, col.3, lines 48-53, col.7, lines 23-27).

23. As per claims 18 and 23, Kumar taught the invention claimed in claims 16 and 21.

Kumar further taught that the step of sending a notification to the user email account comprises sending a copy of the faxed document to the user email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

24. As per claims 19 and 24, Kumar taught the invention claimed in claims 18 and 23.

Kumar further taught that the step of sending a notification further comprises creating a copy of a facsimile document, appending the created copy to an email message, and sending the email message to the user email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37).

25. As per claim 25, Kumar taught the claimed invention including a transmission device (fig.4), comprising:

- a. A processing device (col.8, lines 45-51; processing device such as CPU is an inherent component of a computer); and
- b. Memory (col.8, lines 45-51; memory is an inherent component of a computer) including a notification module that is configured to send a notification that a document was faxed by the transmission device to an email account of the facsimile document sender (col.8, lines 45-67, col.9, lines 1-4).



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26. As per claim 26, Kumar taught the invention claimed in claim 25. Kumar further taught that the notification module is configured to send a copy of the facsimile document to the email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37, col.8, lines 45-51).

27. As per claim 27, Kumar taught the invention claimed in claim 25. Kumar further taught that the notification module is further configured to create a copy of facsimile documents, append them to email message, and send the email message containing the appended copies to the email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37, col.8, lines 45-51).

28. As per claim 28, Kumar taught the invention claimed in claim 25. Kumar further taught that the transmission device is a multifunction peripheral (fig.4; computer).

***Claim Rejections - 35 USC § 103***

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 3-4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al (hereinafter Kumar), US 6,240,445, in view of "Official Notice".

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31. As per claim 3, Kumar taught the invention substantially as claimed in claim 1. Kumar further taught that the step of sending a copy of the transmitted document comprises sending a copy of the transmitted document to user's storage medium or voicemail box address (col.5, lines 36-41, col.8, lines 51-53). Kumar did not specifically teach to send a copy of the transmitted document to a sent items folder of a user email application. However, Official Notice is taken that the concept and advantage of placing an outgoing message in an email outbox folder prior to the transmission or caching sent mail in a sent folder to keep track of what was sent out is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kumar and further cache a copy of the mailed out document to a cache folder to log the emailing history of an user email application.

32. As per claims 4 and 20, Kumar taught the invention substantially as claimed in claims 3 and 16. Kumar did not specifically teach that the user email application executes on a separate computing device. However, Official Notice is taken that it is obvious to place the user email application at separate computing device as a design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kumar and further implement the uses of various email applications to send the notification in order to support various email application users to use Kumar's notification system.

### ***Conclusion***

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33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goodhand et al, US 5,923,848.

34. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl  
February 2, 2005



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